

**REMARKS**

Claims 16 and 18 to 33 are pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

*Applicant respectfully requests that the Examiner acknowledge all claims for foreign priority.*

Claims 16, 18 to 24, 28, and 31 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

In response to the Office Action of July 21, 2009, claim 16 was rewritten to provide that the command sequence is generated in the remote component and the command sequence is transmitted via a communication module, so that this clearly tied the process in claim 16 to a machine or apparatus. As to the Office Action's remarks that there is no tie to a machine in checking for plausibility, claim 21 explicitly provides that the command sequence is checked by the processing unit which is clearly tied to a machine (the feature of checking for plausibility was previously removed from the claim in a previous Office Action response).

To further facilitate matters, however, claim 16 now further provides that the processing unit monitors the engine characteristics, and subsequently the operating data, of the motor vehicle, and that the processing unit determines the type of operating data recording. Claims 18 to 24, 28, and 31 have been similarly rewritten. Withdrawal of the rejections is therefore respectfully requested.

Claims 16, 18 to 20, and 22 to 29 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent 6,611,201 ("Bishop").

As to the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. *See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. *See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986).

As further regards the anticipation rejections, to the extent that the Final Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” M.P.E.P. § 2112; *See Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

Claim 16, as presented, is to a method for recording operating data of a motor vehicle, comprising: generating a command sequence in a remote component; transmitting the command sequence by a communication module in a monitoring unit in the motor vehicle; monitoring a plurality of engine characteristics by a processing unit in the monitoring unit; parameterizing the command sequence by the processing unit; determining a type of operating data recording by the processing unit; processing the command sequence in the processing; and continuously monitoring the operating data by the processing unit, the processing unit determining when components of an engine no longer comply with a predetermined limit or manufacturer's warranty.

As to the Bishop reference, it does not identically disclose (or even suggest) the features of generating a command sequence in a remote component and transmitting the component using a communication module, as provided for in claims 16, 25, 28, and 29. Instead, Bishop refers to a system in which a signal is sent over a nationwide radio paging system to a receiver of a master relay control unit (see Bishop, col. 16, lines 12-15), so that it does not identically disclose (or even suggest) transmitting a command sequence using a communication module, such as an interface to a mobile telephone network. (See Substitute Specification, page 5, lines 16-19).

Further, Bishop does not identically disclose (or even suggest) the generation and transmission of a command sequence, which is a series of instructions that are interpreted and executed by a processing unit to determine what data to record. (See Substitute Specification, page 2, lines 16-18, 27 and 28). The signal discussed in Bishop is simply a recall signal that designates the specific vehicle to be recalled (see Bishop, col. 16, lines 15-

16), so that Bishop does not identically disclose (or even suggest) that the signal is a set of instructions to determine what data to record. The Bishop reference also does not identically disclose (or even suggest) that the signal is generated in a remote component.

Still further, Bishop does not identically disclose (or even suggest) the feature of continually monitoring the operating data by the monitoring unit and determining when components of an engine no longer comply with a predetermined limit or manufacturer's warranty. In this regard, it is believed and respectfully submitted that Bishop specifically teaches away from this feature, since it explicitly indicates that the accumulation or processing of data from the computers to the master relay control unit is made at prescribed time intervals. (See Bishop, col. 14, lines 17-21). Further, Bishop does not identically disclose (or even suggest) that a determination is made when the engine components no longer comply with a manufacturer's warranty.

To facilitate matters however, claims 16, 25, 28, and 29 have been rewritten to provide that the command sequence is parameterized by the processing unit. This feature is not identically disclose (or even suggest) by the Bishop reference.

For the foregoing reasons, claim 16, as presented, is allowable, as are its dependent claims 18 to 24.

Claim 25 is to a device and has features like those of method claim 16, so that claim 25 is allowable for essentially the same reasons as claim 16, as are its dependent claims 26 to 27.

Claims 28 and 29 also include features like those of claim 16, as presented, and they are therefore also allowable for essentially the same reasons.

Claims 21 and 30 to 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bishop in view of U.S. Patent No. 6,704,628 ("Fennel").

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claims 21 and 31 depend from claim 16, as presented, and they are therefore allowable for essentially the same reasons as claim 16, as presented, since the Fennel reference does not cure -- and is not asserted to cure -- the critical deficiencies of the Bishop reference. The Fennel reference contains no disclosure of generating a command sequence in a remote component and transmitting the component using a communication module or parameterizing the command sequence by a processing unit, wherein the processing unit may continually check the operating data to ensure that components still comply with the warranty and any predetermined limits.

Claim 30 depends from claim 29, as presented, and it is therefore allowable for essentially the same reasons as claim 29, as presented, since the Fennel reference does not cure -- and is not asserted to cure -- the critical deficiencies of the Bishop reference.

Claim 32 depends from claim 25, as presented, and it is therefore allowable for essentially the same reasons as claim 25, as presented, since the Fennel reference does not cure -- and is not asserted to cure -- the critical deficiencies of the Bishop reference.

Claim 33 depends from claim 28 as presented, and it is therefore allowable for essentially the same reasons as claim 28, as presented, since the Fennel reference does not cure -- and is not asserted to cure -- the critical deficiencies of the Bishop reference.

As further regards to all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner

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provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03). Applicant asserts that the Examiner's assertion that the generation and storage of the command sequence being obvious is based on the purported knowledge of the Examiner.

Accordingly, claims 16 and 18 to 33 are allowable.

### CONCLUSION

In view of the above, it is respectfully submitted that all of presently pending claims 16 and 18 to 33 are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn. Since all issues raised by the Examiner have been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

Date: \_\_\_\_\_

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